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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,978	08/18/2003	Jay S. Walker	97-558-C1	3402
22927	7590	08/01/2006	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/642,978

Applicant(s)

Walker et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on May 19, 2006 (RCE w/Amdt).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 18, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 19, 2006 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on May 19, 2006 in reply to the previous Office action on the merits, mailed February 21, 2006.
3. The amendment narrowing the scope of independent claim 1, made by applicant in the reply filed May 19, 2006, is hereby acknowledged.

***Claim Rejections - 35 USC § 101***

4. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. To be considered statutory, claimed subject matter requires four things<sup>1</sup>:

(1) the claimed subject matter *must* lie within the ambit of the *four classes* of statutory subject matter enumerated in 35 U.S.C. 101, those being any new and useful *process, machine, manufacture, or composition of matter*;

(2) the claimed subject matter *must not* fall within any of the *three categories* of statutory subject matter *exceptions* enumerated by the courts, those being, *in the absence of any practical application: abstract ideas, laws of nature, and natural phenomena*;

(3) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must not preempt* the underlying abstract ideas, laws of nature, or natural phenomena by foreclosing others from *substantially all other practical applications* of the *same* abstract ideas, laws of nature, or natural phenomena; *and*,

(4) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must* be evidenced in at least one of two possible ways:

(a) by transforming an article or physical object to a different state or thing; or,

(b) by otherwise producing any useful, concrete, and tangible result.

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<sup>1</sup> *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, published by order of the Commissioner for Patents, available in pdf format online on the Internet at: [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

6. Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Method claims 1-5 are drawn to a process, thus meeting the first of the four necessary criteria for the subject matter to be considered statutory. Claims 1-5, however, fail to meet any of the remaining three necessary criteria, for the reasons set forth hereinbelow.

Regarding criteria 2 and 4, method claims 1-5 are drawn merely to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for *merely manipulating an abstract idea* without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Regarding criterion 3, without regard for *whether or not* method claims 1-5 comprise a *practical application* of an *abstract idea* in accordance with criterion 2, evidenced by “useful, concrete, and tangible results,” in accordance with criterion 4, method claims 1-5 are considered to, in any event, *preempt the underlying abstract idea*, since they would foreclose others from *substantially all other practical applications* of the *same* abstract idea (selling of fractional lottery tickets). It has been held that such claims are considered to be unpatentable, for comprising non-statutory subject matter. *In re Schrader*, 22 F.3d 290, 295; 30 USPQ2d 1455, 1459 (Fed. Cir. 1994).

Regarding the fact that use of the invention defined by method claims 1-5 would appear to be clearly illegal (see, for example, Code of Virginia § 58.1-4014), patent claims are no longer rejected as non-statutory simply for being illegal to practice, since it has been held that Congress never intended that the patent laws should displace the police powers of the States. *Juicy Whip Inc. v. Orange Bang Inc.*, 185 F.3d 1364, 1367-68, 51 USPQ2d 1700, 1702-03 (Fed. Cir. 1999).

***Claim Rejections - 35 USC § 112, First Paragraph***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, the specification fails to disclose, in an adequately enabling manner, how “the allocated portion” of the ticket could possibly be “less than the whole of the ticket,” since, when the retailer buys the ticket, 100% of the ticket is “allocated,” in this case to the retailer. The retailer might then choose to “reallocate” or “suballocate” some portion of the ticket less than 100% to some third party, but the remaining portion would still be “allocated” (to the retailer).

Likewise, regarding claims 4 and 5, the specification fails to disclose, in an adequately enabling manner, how any ticket could possibly have any “unallocated portion,” since 100% of every ticket sold/created is allocated at the time of sale/purchase.

Additionally, regarding claim 1, the specification also fails to disclose, in an adequately enabling manner, how “the allocated portion” (in the sense of “the portion being reallocated or suballocated”) could be known/guaranteed to be less than “the whole of the ticket,” since “the monetary value” could be any amount at all, even an amount far greater than the whole ticket.

9. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for: (1) determining a monetary value by using a point-of-sale terminal to calculate the difference between a total sales amount of a sales transaction and the next-higher whole-dollar amount; (2) reallocating a portion of a lottery ticket, the amount of the portion being equal to the determined monetary value; and, (3) determining a monetary value by using a point-of-sale terminal to calculate the amount of change owed to a customer by subtracting a total sales amount of a sales transaction of the customer from the amount of a monetary overpayment received from the customer for the sales transaction, the specification does not reasonably provide enablement for: (1) all possible methods of simply “determining” (claim 1, line 2); (2) all possible methods by which any portion of any conceivable type of ticket could be determined while being simply “based on” (claim 1, line 3) the monetary value; and, (3) all possible methods of simply “determining” (claim 2, line 3) a monetary value, the value being simply “based on” (claim 2, line 3) an amount of change due. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. See MPEP § 2164.08.

By way of example, note that “determining a monetary value using a point of sale terminal,” as claimed, would include within its scope the possible method step of “randomly hitting number keys on the keyboard of the point-of-sale terminal with ones eyes closed, then opening them to see what number was displayed”; and, the portion being “based on the monetary value,” as claimed, would include within its scope the possible method step of “generating a random number and multiplying the random number by the monetary value.”

***Claim Rejections - 35 USC § 112, Second Paragraph***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to which “allocated portion” the recitation, “the allocated portion” (claim 1, line 7) is intended to refer, the “newly reallocated portion,” the remainder of the “originally allocated portion,” or the “cumulative allocated portion” (i.e., all allocated portions collectively).

Additionally, it is unclear if the recitation of “change due” (claim 2, line 3) refers to the entire amount of the monetary “balance due” to the customer after receiving a monetary overpayment for the sales transaction, or else only to that portion of the entire amount of the monetary balance due to the customer comprising “coins due” after receiving a monetary overpayment for the sales transaction (i.e., the fractional amount of change due--the amount of change due greater than the next-lower whole-dollar amount of change due, for example, 57¢ if the change due were \$6.57).



***Double Patenting - Nonstatutory***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). See MPEP § 804.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

A registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,267,670 (08/822,709). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

14. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,582,304 (09/836,409).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

15. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,887,153 (10/424,362).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

16. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 09/045,036. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/107,971. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/457,101. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/643,803. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (JP 57120172).

Kobayashi discloses a method comprising: determining a monetary value using a point of sale terminal; allocating a portion of a ticket, the portion being based on the monetary value, in which the allocated portion is less than the whole of the ticket; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and, storing the ticket identifier and the portion identifier. See, in particular, Figure 2 (showing whole tickets A1, A2, A3, and fractional ticket B), and the English language abstract.

Regarding claim 2, in the method of Kobayashi, the determining a monetary value is inherently based on an amount of change due for a purchase.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilssen (US 5,083,784), in view of Burke (US 6,112,191), and further in view of the admitted prior art, as described in US 6,267,670 (08/822,709), incorporated by reference in paragraph 1 of the instant specification.

Nilssen discloses a method comprising: determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and, storing the ticket identifier and the portion identifier, but Nilssen discloses neither determining the monetary value by use of a point-of-sale terminal, nor that the allocated portion is less than the whole of the ticket.

However, Burke discloses using a point-of-sale terminal to determine a monetary value, and the admitted prior art includes the selling of fractional lottery tickets (see, for example, column 1, lines 66 and 67, of US 6,267,670 (08/822,709), incorporated by reference in paragraph 1 of the instant specification.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Nilssen so as to have the lottery purchase effected at a point-of-sale terminal, in accordance with the method of Burke, in order to facilitate the purchase by determining the monetary value by use of the point-of-sale terminal, and to include that the allocated portion could be less than the whole of the ticket, in accordance with the admitted prior art, in order to satisfy existing market demand for fractional lottery tickets.

Regarding claim 2, Nilssen fails to disclose that the step of determining a monetary value is based on an amount of change due for a purchase. However, Burke discloses using an amount of change to determine a monetary value for an added purchase. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Nilssen so as to use an amount of change, in accordance with the teachings of Burke, to determine a monetary value for the lottery purchase of Nilssen, in order to make the lottery purchase as convenient as possible, hence as attractive/desirable as possible, thereby generating as many sales as possible.

Regarding claims 3-5, Nilssen fails to disclose the steps of : selecting the ticket from a plurality of tickets; selecting a ticket having an unallocated (available to purchase) portion at least as great as the monetary value (amount being purchased); and, determining a set of tickets that each have an unallocated (available to purchase) portion at least as great as the monetary value (amount being purchased) and selecting the ticket with the smallest unallocated portion within that set of tickets. However, such steps are self-evident, hence obvious, to those of ordinary skill in the art, since such steps comprise details that would all suggest themselves to

one of ordinary skill in the art, simply by the nature of the problem to be solved, in the ordinary course of implementing a solution/design. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Nilssen so as to perform any of the recited steps, simply as a matter of design choice, since such steps could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

#### *Response to Arguments*

24. Applicant's arguments filed May 19, 2006 have been fully considered but they are not deemed persuasive.

25. Regarding the argument that, since the claims are drawn to the production of a disembodied data structure, the examiner has assumed that the claims are non-statutory because they must therefore fail to produce a useful, concrete, and tangible result, the examiner has made no such assumption. As noted in the rejection, that stated conclusion was the decision of the Court, not an assumption of the examiner. Applicant's opinion to the contrary is noted, but irrelevant.

26. Regarding the argument that the examiner's "insistence that an *outputting* step be performed by a computer [is] improper," the examiner has made no such insistence.

27. Regarding the argument that applicant “[does] not understand why performing the *outputting* step by a point-of-sale terminal would satisfy the examiner’s standard for statutory subject matter, but *determining a monetary value using a point-of-sale terminal*, as currently recited, does not,” the standard is not the examiner’s personal standard as implied/believed by applicant, it is a standard based on decisions of the Court. In any event, upon consideration, applicant’s argument in this regard is actually correct, recitation of performing the outputting step by a point-of-sale terminal would *not* be sufficient to render the claims statutory.

28. Regarding the arguments *vis-à-vis* the *State Street* decision, the *State Street* test of a “practical application, i.e., ‘a useful, concrete, and tangible result,’” was announced in the context of transformation of data by a machine, thus is not even directly relevant to consideration of applicant’s instant non-machine-implemented method claims.

Machines and machine- implemented processes have generally been considered statutory subject matter, except in the special case where mathematical algorithms were involved. A machine-implemented claim starts out with a presumption of being statutory subject matter. *State Street* simplifies analysis of machine-implemented claims. It appears that all that is necessary for a machine claim or a machine-implemented process claim to be statutory subject matter is that the data that is transformed is representative of or constitutes physical activity or objects, so that the result has some practical utility. With a non-machine-implemented method, no implied transformation by a machine can be relied on to make the method “useful” or “concrete and tangible.”



29. Regarding the argument that the double-patenting rejection should be a statutory double-patenting rejection if the present claims are “identical” in scope to the issued claims, the rejection explicitly stated that, “the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.” Regarding applicant’s professed “confusion” and “loss as to how to proceed” to overcome the rejection, the Office action also conveniently included the following tidbit, helpfully advising applicant that, “a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.”

30. Regarding the argument that the examiner should reconsider and clearly state whether or not the claims are identical, the examiner cannot state it any more clearly than it was stated, “the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.” See MPEP § 804.

31. Regarding the Graham factual inquiries, all of the features of the instant claims are found in the claims of the prior-filed patent, thus no obviousness modifications are necessary.

32. Regarding the argument that the test to be applied is a one-way (i.e., easier) test, applicant is correct, and that is the test that has been applied.

33. Regarding the argument that the obviousness-type double patenting rejection failed to consider all of applicant's claim limitations, all of applicant's claim limitations were indeed properly considered, and none were ignored. Note that the disclosure in a reference (in this case the claims of the earlier-filed patent) must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

34. Regarding the argument that claims 1-12 of U.S. Patent No. 6,267,670 do not include the step of "allocating a portion of a ticket, the portion being based on the monetary value," claims 1-12 of U.S. Patent No. 6,267,670 indeed require, though recited using a different set of words, the step of "allocating a portion of a ticket, the portion being based on the monetary value," since "allocating a portion of a ticket, the portion being based on the monetary value" is what necessarily occurs in the "method for performing a lottery ticket transaction at a point-of-sale terminal" in performing the recited step of "calculating a fractional amount of a full lottery ticket, the full lottery ticket having a full price, the fractional amount being based on the change amount and the full price," in combination with the other recited steps for effecting the transaction, as set forth, for example, in claim 5 of the patent.

35. Regarding the argument that the obviousness-type double patenting rejection fails to set forth any motivation to modify the patent, no motivation is required because no modification is necessary. The instant claims are anticipated by the patent, since the disclosure in a reference

must show the claimed elements arranged in the same manner as in the claims, but ***need not be in the identical words*** as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

36. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment narrowing the scope of the claims, and the consequent new grounds of rejection.

37. Regarding the arguments remarks *vis-à-vis* previous decisions of the Board of Patent Appeals and Interferences in cases involving applicant, applicant's disagreement with the previous decisions is, again, noted, but irrelevant.

### ***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to the disclosure.

39. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

July 28, 2006



7/28/06

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627